

REMARKS

The Office Action mailed September 20, 2006 considered claims 1-10, 24, 42, 43 and 45-51. Claims 2-10, 24, 43, 45-51 were rejected under 35 U.S.C. 101 because Office Action asserts that the claimed invention is directed to non-statutory subject matter. Claim 45 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-4, 10, 24, 42, 51 were rejected under 35 U.S.C. 103(a) as being unpatentable over *De Meno et al.* (US 6,721,767) hereinafter *De Meno* in view of *Traversat, et al.* (US 6,161,125) hereinafter *Traversat*. Claims 5-9, 43, 45-50 were rejected under 35 U.S.C. 103(a) as being unpatentable over *De Meno* in view of *Traversat* and further in view of *Hammack et al.* (US 6,449,624) hereinafter *Hammack*.¹

By this paper, claims 24 and 51 have been amended, and new claims 52-54 have been added, such that claims 1-10, 24, 42, 43, 45-54 remain pending of which claims 1, 24, 42 and 51 are the only independent claims.

As a preliminary matter, the applicants would like to thank the Examiner for the courtesies extended during the telephonic interview on November 15, 2006.

In the claims of the present application, claims 1 and 42 (directed to a method) and 24 and 52 (directed to a computer program product for the method), applicant has defined a method of reverting a current configuration setting for a software application to a previous *configuration setting* so that the software application will be capable of operating on data in the same manner as it did with the previous configuration settings that were used by the application software. Based upon a request from a user or a selection from the software application, the method first requires generating changes to the software application's configuration settings. A configuration store is then updated by storing therein the changed application configuration settings of the software application to maintain a history of one or more configuration setting changes for the software application. Next, a package is generated that uniquely identifies the contents of the package and the changes to the software application's configuration settings so that the package can be later recalled and used when reverting the configuration settings of the software

¹ Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

application back to a state that existed prior to the changes in the configuration settings. The package is then stored in a software application configuration log, from which it is later retrieved when it is desired to revert the configuration settings of the software application back to a state that existed prior to the changes in the configuration settings so that the software application will be capable of operating on data in the same manner as it did with the previous configuration settings that were used by the application software.. Finally, the contents of the package are used to revert the configuration settings back to those that existed prior to the changes identified by the package so the software application will thereafter be capable of operating on data in the same manner as it did prior to such changes.

Rejection Under 35 U.S.C. 101

As mentioned above, Claims 2-10, 24, 43, 45-51 were rejected under 35 U.S.C. 101 because the Office Action asserts that the claimed invention is directed to non-statutory subject matter. Applicants discussed with the Examiner that several of these claims do not recite computer readable media. However, after further review, applicants recognize that due to the multiple dependencies, these claims do in fact recite computer readable media. Applicants apologize for the misunderstanding. With regards to claims 24 and 51, claims 24 and 51 have been amended to recite computer-readable *storage* media. The Examiner seemed to indicate during the telephonic interview that this amendment would overcome the 35 U.S.C. 101 rejection.

Rejection Under 35 U.S.C. 112

Regarding claim 45, claim 45 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action notes that claim 45 recites that a header portion comprises a call to a reversion routine. The Office Actions states that "the header portion of the package is not a program, nor is it executable or executed, but contains information about the contents of the package, it could not contain a call or routine." Applicants respectfully traverse this rejection and refer the examiner to paragraphs [022] and [039] of the specification of the present application which describe and enable the inclusion of a call in the header portion. Specifically, paragraph [022] states that "Header 115 of Package 110 may contain a reversion routine, which as described in greater detail below, can be called to assist Application 105 to undo, redo or rollback to a previous configuration setting." Paragraph [039]

states that "[t]he [reversion] routine may be embedded within the header of the configuration information..." This issue was discussed with the Examiner during the telephonic interview, and the Examiner seemed to indicate that in view of the disclosure in the specification, traversal of the rejection seemed to be sufficient to overcome the rejection. Notably, the rejection as set forth in the Office Action would appear to be strong evidence that claim 45 is patentable over the art cited by the Office Action. In particular, the Office Action notes that "[h]eader data is not operative, although it can contain pointers to functions or other operations." Thus, applicant's disclosure and claim to header data including calls to routines would appear to be novel over the art and at least undisclosed in the art cited by the Office Action. Additionally, it would also suggest that this particular use of calls in a header would be non-obvious to one of skill in the art.

Rejection Under 35 U.S.C. 103

With regard to the rejection under 35 U.S.C. 103, applicants respectfully traverse the rejection. In particular, the combination of references is improper for at least the reason that there is no appropriately stated motivation to combine the references. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." MPEP 2143.01. The Office Action does not state which three of these sources is being used, however, applicants will address each of the three.

The nature of the problem to be solved is not an appropriate motivation in this case, because Traversat and De Meno are each directed to different problems than each other, and the references are each directed to a different problem than the present application. In particular, the present application is directed to reverting current configuration settings for a software application to a previous configuration setting. See e.g. claim 1. Traversat, in contrast is directed to facilitating the transfer of user settings to different computers on a network. This allows a user to transfer their environment from one client to another so that the user does not have to reset the environment. See e.g. Traversat at col. 7, lines 47-49. De Meno is directed to allowing data, not configuration settings to be rolled back when data has been unintentionally changed, infected by a virus, corrupted, or inadvertently saved. See e.g. De Meno at col. 3, lines 63-68. Thus, because of the differences in the problem to be solved, the problem to be solved is not an appropriate motivation.

The teaching of the prior art are not an appropriate motivation to combine Traversat and De Meno. As mentioned previously, Traversat simply teaches transferring user settings while De Meno teaches rolling back data. Neither suggests or explicitly teaches substituting user settings for data. Rather, they each teach or suggest a solution to individual problems. In one example, this is evident from the stated motivation that the Office Action provides. For example, the Office Action states that one motivation to combine De Meno and Traversat can be found because the combination "would have given those skilled in the art the tools to improve the invention by allow[ing] users who must use different client computers at different locations to maintain personal preferences to the application and configuration data. This gives the user the advantage of having configuration preferences saved for future use on many different computers." However, this is really only a motivation to use the system disclosed by Traversat. The stated motivation does not even address the issue of "reverting configuration settings...back to a state that existed prior to the changes in the configuration settings" which is missing from De Meno.

The Office Action states that "storing the package in a software application configuration log would have given those skilled in the art the tools to improve the invention by allowing administrators to manage configurations on a server [such that a] user has the advantage of having a centralized repository for all saved configurations." However, neither Traversat, nor De Meno suggest that managing configuration settings on a server would be an advantageous activity to be carried out. The only suggestion of this advantage is in the applicant's disclosure, which may not be used as a guide.

Finally, the Office Action states that it would have been obvious to combine the references because the combination "would have given those skilled in the art the tools to improve the invention by having a system which supports distributed management of client configurations [giving] the user the advantage of being able to have the ability to have a backup source for configuration settings." However, neither Traversat, nor De Meno suggests a need or teaches a solution for having the ability to have a backup source for configuration settings. The only teaching that this would be advantageous is applicant's disclosure, which may not be used as a guide.

As such, the teachings of the prior art are not an appropriate motivation applicable to the combination of Traversat and De Meno.

The third acceptable motivation to combine references is the knowledge of persons of ordinary skill in the art. Based on the comments on page 19 of the present Office Action, this appears to be the reasoning relied upon for the combination. Specifically, the Office Action states that "as long as [reconstruction] takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper." As a preliminary matter, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. MPEP 2143.01. Rather, it appears that when relying on the knowledge which was within the level of ordinary skill at the time the claimed invention was made, the analysis focuses on a particular principle known to one of skill in the art. See *In Re Rouffet* at 1359.

Notably, *In Re Rouffet* describes some of the challenges faced when making and overcoming obviousness rejections based on 35 U.S.C. 103. In particular *In Re Rouffet* notes that "virtually all inventions are combinations of old elements." *Id.* at 1357 (internal citations omitted). Further, "[i]f identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *Id.* As such, "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *Id.* The Office Action "must identify specifically the principle, known to one of ordinary skill that suggests the claimed combination." *Id.* at 1359.

While applicants do not acquiesce to the assertion that all of the elements of the recited claims are included in the art cited by the Office Action, it is respectfully submitted that simply because one of skill in the art might have been aware of combinable components, and that simply because software components may be adaptable and pluggable, it does not therefore follow that it would have been obvious to combine the elements. If such were the case, it would be rare for any computer implemented method to be eligible for patent protection.

Thus, it is respectfully submitted that the Office Action must recite some principle that suggests the claimed combination. The Office Action has simply not done this. Rather the Office Action has recited either principles of a single given piece of prior art that would be useful or has recited features of the applicant's invention that would be useful as discussed above. These are not principles known to those of skill in the art that would have suggested the

combination, but rather either motivation to use a known apparatus, or motivation to pick and choose components to arrive at the applicant's invention. As such, the Office Action has not properly used the knowledge of persons of ordinary skill in the art to maintain a prima facie case of obviousness.

Because the Office Action does not demonstrate motivation to combine due to the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art, a prima facie case of obviousness under 35 U.S.C. 103 has not been made. As such, the rejection should be withdrawn.

New Dependent Claims

With regard to the dependent claims, three new dependent claims have been added. Specifically, claim 52 recites: "displaying a graphical user interface, the graphical user interface including filtering functionality for filtering application configuration information based on a per application basis such that configuration information for a specific application can be selected, and wherein retrieving the stored package is performed in response to a user selection of an application from the graphical user interface. Neither Traversat nor De Meno illustrates filtering configuration settings on a per application basis. Rather, De Meno illustrates that a folder view can be used to find a file and to open a specific version of the file. De Meno at col. 5, lines 40-57. Traversat illustrates restoring an entire environment, and not application specific settings. Traversat at col. 7, lines 44-49. In any case, Traversat does not disclose displaying a graphical user interface where configuration settings are filtered on a per application basis.

Claim 53 recites "further comprising encrypting the package." Neither Traversat nor De Meno disclose encrypting configuration settings packages. For that matter, neither Traversat nor De Meno disclose encryption whatsoever.

Rejection of Claim 45 Under 35 U.S.C. 101 Seems to Indicate That Claim 45 is Patentable Over the Cited Art

Further, with respect to claim 45, as argued above, the rejections under 35 USC 101 as set forth in the Office Action would appear to be an admission that claim 45 is patentable over the art cited by the Office Action. In particular, the Office Action notes that "[h]eader data is not operative, although it can contain pointers to functions or other operations." Thus, applicant's disclosure and claim to header data including calls to routines would appear to be undisclosed in

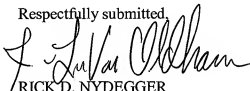
the art cited by the Office Action. Additionally, it would also suggest that this particular use of calls in a header would be non-obvious to one of skill in the art.

In view of the foregoing, Applicants respectfully submit that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicants acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicants reserve the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicants specifically request that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 20th day of December, 2006.

Respectfully submitted,



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